



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/764,219

01/23/2004

Wolfgang Dinkelacker

K0004/7005

9150

21127

7590

07/27/2006

KUDIRKA & JOBSE, LLP
ONE STATE STREET
SUITE 800
BOSTON, MA 02109

EXAMINER

WERNER, JONATHAN S

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/764,219	Applicant(s) DINKELACKER, WOLFGANG	
	Examiner Jonathan Werner	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/24/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-28 is/are pending in the application.
- 4a) Of the above claim(s) 24-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to Applicant's amendment submitted 4/24/06.

Election/Restrictions

2. Newly submitted claims 24-28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims drawn to a method for pre-forming gingival tissue over a jaw implant body and claims drawn to a jaw implant are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process of pre-forming gingival tissue over a jaw implant body can be accomplished by using a jaw implant that is not deformable.

3. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Priority

4. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Europe on 1/25/03. It is noted, however, that applicant has not filed a certified copy of the 03001688.5 application as required by 35 U.S.C. 119(b).

Claim Objections

5. Claim 18 is objected to because of the following informalities: "a temporary attachment forming jaw tissue" should be "a temporary attachment for forming jaw tissue." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 9, 14 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As to claims 9 and 20, since the base part and head part of the attachment are not clearly defined as either separate from the attachment or actual parts of said attachment, it becomes unclear to the Examiner how said head part can be same as the screw head. As to claim 14, it not understood how the implant head "forms" the base part.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-8, 11, 14-19, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Durr et al. (US 5,026,280). As to claims 1 and 18, Durr discloses a jaw implant comprising a screw (20) that attaches a superstructure (28) to the implant body; an implant body (10/12) having an implant head and a threaded bore extending from the implant head in the direction of a longitudinal axis of the implant body (Figure 1); an attachment (18) capable of forming jaw tissue above the implant head after the implant body has been inserted into a jawbone; said attachment having a base part (bottom half of 18) and a head part (top half of 18); a molded piece made of biocompatible and elastic material (column 5, lines 40-41) located between the base part and the head part; the screw passing through the head part, molded piece and the base part and engaging the threaded bore (15, Figure 1) to fasten the attachment to the implant head; and wherein the molded piece is capable of being deformed under the action of a screw so its deformation is transferred to surrounding jaw tissue (column 6, lines 26-28). As to claim 2 as understood, Durr shows a jaw implant (10,12) wherein the implant head has a shape and wherein the base part has a first surface shaped to fit to the implant head (16) and has a second surface in contact with the molded piece (Figure 1). As to claim 3, the second surface of the base part has a shape profile that can predetermine the

Art Unit: 3732

type of deformation of the molded piece (Fig 1) under force from the screw (column 6, lines 26-28). As to claim 4, the head part has a surface that is in contact with the molded piece and has a shape profile which can determine the type of deformation of the molded piece (Fig 1). As to claim 5, Figure 4 shows the base surface and the head surface each can have a convex shape profile which results in a barrel-shaped deformation of the molded piece. As to claim 6, Figure 3 shows the head part surface has a shape profile which tapers toward the molded piece and can predetermine a deformation of the molded piece. As to claims 7 and 8, the base part has a surface in contact with the molded piece and wherein one of the base part surface and the head part surface has a radially asymmetric shape profile (Figure 3) and the radial direction of deformation can be selected by rotating one of the base and the head around the longitudinal axis. As to claims 11 and 21, the molded piece has a cylindrical shape (Figure 4). As to claim 14, the implant head forms the base part (Figure 1). In re claim 15, the implant head (16) and the base part have radially asymmetrical surfaces that interlock (Figure 1). As to claim 16, at least one of the base part and the head part is attached to the molded piece (Figures 1,3). As to claim 17, the threaded bore (15) receives a screw (20) that fastens a superstructure (28) to the implant body (Figure 1). As to claim 19, the implant head comprises a profile in the form of opposing slopes (16). With regard to statements of intended use and other functional statements, Examiner notes that such statements do not impose any specific structural limitations on the claims sufficient to be distinguishable over the prior art of record, which is capable of being used as claimed if one so desires to do so. Examples of such statements include

how the molded piece is deformable under the action of a screw, how the surrounding jaw tissue is formed accordingly, and how the molded piece is extended in directions of the buccal and lingual sides, among others.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9, 12-13, 20 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durr in view of Mozsary (4,552,532). As to claims 9 and 20, Durr discloses a jaw implant as previously described, however, fails to show the head part of the temporary attachment is the screw head. Mozsary, however, teaches an implant system wherein the screw (50) has a head (52) and wherein the head part of the attachment (48) is the screw head (52). Therefore, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to make the head part of the attachment the screw head in order to cushion forces on the crown as taught by Mozsary. In re claims 12 and 22, Durr discloses a jaw implant as previously described, however, fails to disclose the molded piece has a height at least equal to a thickness of gingival tissue. Mozsary teaches an attachment (48) for a jaw implant which has a height at least equal to a thickness of gingival tissue (28). Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to

make the molded piece have a height at least equal to a thickness of gingival tissue in order to make the appearance cosmetically acceptable as taught by Mozsary. In re claims 13 and 23, Durr discloses an attachment for a jaw implant as previously described, however, fails to show the molded piece is silicone. Mozsary teaches an attachment (48) for a jaw implant that is constructed of silicone (col 3, ln 50-52). Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to fabricate the molded piece from silicone material in order to ensure the component is biocompatible with the human body as taught by Mozsary.

Response to Arguments

9. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that the elastic intermediate element is not sufficient to read on Applicant's claimed temporary attachment. Applicant asserts that no forming effect can be exercised on the gingival tissue by the deformation of the element in the Durr patent since tightening the post can only compress the lower portion of the element and that the periphery of said portion is covered by a spacer element which prohibits any deformation. However, Applicant has failed to claim how the molded piece is deformable as described herein. As is, the "action of the screw" as claimed does not necessarily have to compress the molded piece to transfer its deformation to surrounding jaw tissue. Instead, such a statement as claimed is a recitation of the intended use of the claimed invention, and must result in a structural difference between the claimed invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, Durr discloses that the elastic element can be deformed by tightening the implant post as described above (column 6, lines 26-28).

10. Additionally, Applicant asserts that the Durr patent does not deal with the problem of forming the soft tissue surrounding the implant before a superstructure is attached to the implant. However, as described in the rejection set forth above, such statements of functionality carry little patentable weight in a device claim since they do not impose any structural limitations on the claims distinguishable over the prior art of record, which is capable of having soft tissue form around the implant before a superstructure is attached to the implant.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 3732

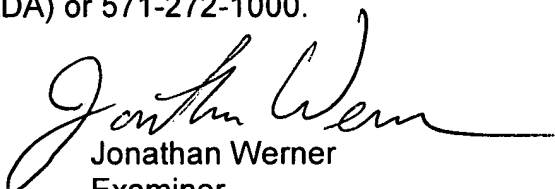
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Werner whose telephone number is (571) 272-2767. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Art Unit: 3732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jonathan Werner
Examiner
TC 3700

7/19/06



MELBA N. BUMGARNER
PRIMARY EXAMINER